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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/686,425
Filing Date: October 15, 2003
Appellant(s): ANDERSON ET AL.

Samuel Borodach
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 13, 2010 appealing from the Office action mailed May 27, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,117,199	Frank et al	10-2006
5,191,525	LeBrun et al	3-1993

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2: the limitations "a request", "information" lack proper antecedent basis;

Claim 7: the limitation "information" lacks proper antecedent basis;

Claim 9: the limitations "information", lack proper antecedent basis;

Claim 10: the limitations "information", lack proper antecedent basis;

Claim 11: the limitations "a request", "information" lack proper antecedent basis;

Claim 12: the limitations "the information", lack proper antecedent basis;

Claim 13: the limitations "the information", lack proper antecedent basis;

Claim 14: the limitation "a user selection" lacks proper antecedent basis;

Claim 15: the limitations "the information", lack proper antecedent basis;

Claim 16: the limitation "information", "a user", lack proper antecedent basis.

Claims 17-46 contain similar 112 issues.

The Applicant is requested to carefully review all pending claims to ensure that they comply with the requirement of 112 2nd paragraph.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable Frank et al (US Patent 7,117,199) in view of LeBrun et al (US 5,191,525).

4. As per claim 1, Frank et al teach a method comprising:

presenting an interactive, graphical depiction of a form through a computer network and allowing for selection of a desired location on the form (**at least column 1, lines 34-41; map**);

receiving a request for information relating to a location on the form selected by a user, the selection and the request being made through interaction with the graphical depiction of the

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form (**at least column 1, lines 34-41, column 6, lines 18-29; user query via map, also by clicking on map**); and

delivering information to the user through the network in response to the request wherein the delivered information includes at least one of the following relating to the selected form location: planning information, consulting materials, research, and compliance information (**at least column 1, lines 20-27, 41-67; documents retrieved relating to user query**).

Frank et al teach a graphical depiction of a form such as a map but fails to teach wherein the form *is a document with one or more areas for insertion of information*. However, LeBrun et al teach an image of a tax form (**see at least fig 6**). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine LeBrun et al with Frank et al because doing so would allow for information on a particular region of the tax form to be displayed.

5. As per claim 2, Frank et al further teach:

receiving a request for information relating to a second (**at least column 27, line 35-column 28, line 10; subsequent interactions**) selected location on the form selected by the user through another interaction by the user with the graphical depiction of the form (**at least column 1, lines 34-41; map**); and delivering additional information to the user through the network, wherein the additional information includes at least one of the following relating to the second selected form location: planning information, consulting materials, research or compliance information **least column 1, lines 20-27, 41-67; documents retrieved relating to user query**).

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6. As per claim 3, Frank et al fails to teach wherein the form comprises *a tax form*. However, LeBrun et al teach an image of a tax form **(see at least fig 6)**. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine LeBrun et al with Frank et al because doing so would allow for information on a particular region of the tax form to be displayed.
7. As per claim 4, Frank et al teach wherein the selected form location corresponds to a section of the form identified by an alphanumeric designation **(at least column 6, line 40-45, column 7, line 3-7, column 8, lines 8-18)**.
8. As per claim 5, Frank et al teach retrieving, from a database, ideas that are linked to the selected form location; and delivering the ideas to the user through the network **(at least column 1, line 61-column 2, line 16; documents are ranked)**.
9. As per claim 6, Frank et al teach including providing to the user a list of hyperlinks for information from third-parties that relates to the selected form location **(at least column 1, lines 50-56)**.
10. As per claim 7, Frank et al teach wherein at least one of the hyperlinks provides access to pages that are pre-populated with information relating to the selected form location **(at least column 1, lines 50-56, column 5, line 59-column 6, line 10)**.

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11. As per claim 8, Frank et al teach wherein at least one of the hyperlinks provides access to information from subscription-based services **(at least column 13, lines 6-16)**.

12. As per claim 9, Frank et al teach wherein at least one of the hyperlinks provides access to pages created based on a search of information contained in the ideas **(at least column 1, line 50-column 2, line 17, column 5, line 59-column 6, line 10)**.

13. As per claim 10, Frank et al teach receiving an indication of the user's selection of a hyperlink in the list; authenticating the user to a third-party site associated with the selected hyperlink in a manner that is transparent to the user; and providing to the user information relating to the selected form location, wherein the provided information is obtained from the third-party site **(at least column 13, lines 6-32, column 5, line 59-column 6, line 10)**.

14. As per claim 11, Frank et al teach presenting an interactive depiction of a map through the network and allowing for selection of a desired jurisdiction **(at least column 1, lines 34-41; map)**; receiving a request for information relating to a selected geographic location on the map in response to the user's interaction with the depiction of the map **(at least column 1, lines 34-41, column 6, lines 18-29; user query via map)**; and delivering additional information to the user through the network, wherein the additional information relates to the selected geographic location **(at least column 1, lines 20-27, 41-67; documents retrieved relating to user query)**.

15. As per claim 12, Frank et al fail to teach wherein the form comprises *a tax form*, and wherein the information relating to the selected form location and the additional information relating to the selected geographic location comprise *tax-related information*. However, in the

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same field of endeavor, LeBrun et al teach an image of a tax form (**see at least fig 6**). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine LeBrun et al with Frank et al because doing so would allow for information on a particular region of the tax form to be displayed.

16. As per claim 13, Frank et al teach wherein the form relates to a specified subject, (**at least column 1, lines 20-67; documents retrieved relating to user query**) but fails to teach wherein the information relating to the selected form location and the additional information relating to the selected geographic location comprise *one or more sources of law relating to the specified subject, the sources of law including at least one relevant statutes, regulations or legal decisions*. However, it would have been obvious to one of ordinary skill in the art to include this limitation in Frank et al as modified by LeBrun et al above because doing so would allow for tax regulations for a particular part of the tax form to be displayed.

17. As per claim 14, Frank et al teach wherein presenting the interactive map occurs in response to receiving a user selection from among a plurality of available interactive maps (**at least column 7, lines 30-62, column 6, lines 30-63**).

18. As per claim 15, Frank et al teach wherein the form relates to a specified subject and wherein the interactive map comprises a plurality of geographic regions about which information relating to the specified subject may be obtained, the method including delivering to a user, through the network, information relating to the specified subject and associated with a particular geographic region selected by the user (**at least column 1, lines 34-56**).

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19. As per claim 16, Frank et al teach wherein the form relates to a specified subject and wherein the interactive map depicts a plurality of countries **(at least fig 2)** about which information relating to the specified subject may be obtained, the method including delivering to a user through the network information relating to the specified subject and associated with a particular country selected by the user **(at least column 1, lines 34-56, fig 2, column 6, lines 30-63)**.

20. As per claims 17-46, these claims contain similar limitations as claims 1-16 above and therefore are rejected under the same rationale.

(10) Response to Argument

112 rejection:

The 112 rejection is withdrawn in light of the amendments made in the Amendment After Final filed July 15, 2009.

103 rejection:

Argument: *It would have not been obvious to combine Frank and LeBrun.*

In response, the Examiner respectfully disagrees. Frank et al teach a method and system that presents an interactive depiction of map to a user **(see at least column 1, lines 34-41)**. Frank et al fail to explicitly teach *wherein the form is a document with one or more areas for insertion of information*. However, LeBrun et al teach an image of a tax form, which is a document with one or more areas of insertion of information **(see at least fig 6)**. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine LeBrun et al with Frank et al because doing so would allow for information on a particular region

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of the tax form to be displayed. Both Frank et al and LeBrun et al are directed to the displaying of images. This combination is merely simple substitution of one known element for another to obtain predictable results. The image of the tax form is substituted for the image of the map in order to create a system that presents an interactive depiction of a tax form that allows a user to interact with the image of the tax form to obtain information on the different areas of a tax form.

It is noted that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. Under KSR, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. Thus the claimed subject matter likely would have been obvious under KSR.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ramsey Refai/

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